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1 UNITED STATES PATENT AND TRADEMARK OFFICE
2

4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex parte* DOUGLAS S. FOOTE and RORY W. MACLEOD
8

10 Appeal 2009-000394
11 Application 09/522,085
12 Technology Center 3600
13

15 Decided: October 15, 2009
16

18 Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A.
19 FISCHETTI, *Administrative Patent Judges.*
20
21 FETTING, *Administrative Patent Judge.*

22 DECISION ON APPEAL

1

STATEMENT OF THE CASE

2 Douglas S. Foote and Rory W. MacLeod (Appellants) seek review under
3 35 U.S.C. § 134 (2002) of a final rejection of claims 1-8, 22, 23, and 25-29,
4 the only claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7

SUMMARY OF DECISION¹

8 We REVERSE and ENTER A NEW GROUND PURSUANT TO 37
9 C.F.R. 41.50(b).

10

THE INVENTION

11 The Appellants invented a way of modifying self-service terminals
12 (SSTs) in the form of automated teller machines (ATMs) to: provide a
13 consistent user interface; reduce the degree of security risk from fraud by a
14 third party observing a user's PIN as it is entered or the balance in a user's
15 account if this balance is presented on the ATMs display; and reduce the
16 annoyance in inclement weather to input information to a touch input

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed January 4, 2008) and Reply Brief ("Reply Br.," filed April 2, 2008), and the Examiner's Answer ("Ans.," mailed April 2, 2008).

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1 mechanism ATM or to come into contact with a cold, soiled, or germ laden
2 touch input mechanism. (Specification 1:4 – 2:4).

3 An understanding of the invention can be derived from a reading of
4 exemplary claim 1, which is reproduced below [some paragraphing added].

5 1. A method comprising:

6 a) in a group of ATMs,

7 i) all of which are located in public places,

8 ii) all of which are connected to a financial
9 network;

10 iii) all of which are operable to dispense cash to
11 customers in response to customer commands;

12 iii) in which is contained a sub-group of ATMs in
13 which the ATMs are not capable of dispensing
14 cash in response to commands issued by a
15 customer from a cellular telephone,

16 identifying an ATM in the sub-group; and

17 b) modifying said identified ATM into a retro-fitted ATM
18 which dispenses cash in response to commands received from a
19 cellular telephone.

20 THE REJECTION

21 The Examiner relies upon the following prior art:

Norris	US 5,940,811	Aug. 17, 1999
Gustin	US 6,012,048	Jan. 4, 2000
Suer	US 6,431,439 B1	Aug. 13, 2002

22 Claims 1-8, 22, 23, and 25-29 stand rejected under 35 U.S.C. § 103(a) as
23 unpatentable over Suer, Norris, and Gustin.

ISSUE

The issue of whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-8, 22, 23, and 25-29 under 35 U.S.C. § 103(a) as unpatentable over Suer, Norris, and Gustin turns on whether the references showed that it was predictable to use cellular telephones to input information into an ATM.

7 FACTS PERTINENT TO THE ISSUES

8 The following enumerated Findings of Fact (FF) are believed to be
9 supported by a preponderance of the evidence.

10 *Facts Related to Appellants' Disclosure*

11 01. The term "wireless telephone" includes any wireless
12 communication device for facilitating telephone conversations,
13 and is not restricted to a conventional cellular telephone.
14 Specification 2:19-21.

15 *Facts Related to the Prior Art*

16 *Suer*

17 02. Suer is directed to a hand-held device to record financial
18 transactions information and make an electronic record of the
19 transaction, so that the user can electronically store information
20 about a check transaction while writing the check. Suer 3:54-58.

21 03. Suer's device "provides a check writing surface that supports a
22 check as it is being filled out by the user, that captures the
23 handwritten payee information as it is being written, and that

1 stores the payee information in a bit-map format [...] in the
2 device's memory." Suer 3:61-65

3 04. Suer's "portable hand-held device may automatically grant an
4 accounting software program, such as Quicken, access to the
5 financial transaction information." Suer 4:8-11.

6 05. Suer's "device may [use] a transceiver, *e.g.*, such as an infrared
7 (IR) transceiver, for wireless communication between the device
8 and a terminal unit, such as a personal computer, an ATM, or a
9 terminal at a merchant's site" to transfer information about a
10 financial transaction to accounting programs running on the PC.
11 This allows the user to more quickly and easily communicate with
12 the terminal unit. Suer 4:30-41.

13 06. Suer's "Information Storage Device may be synchronized with
14 the Host PC [...] by a communications link, such as a wireless
15 link using IR pulses, RF pulses, or any other wireless
16 communications link." Suer 13:18-23.

17 *Facts Related To Differences Between The Claimed Subject Matter And*
18 *The Prior Art*

19 07. None of the references describe or suggest using a cellular
20 telephone to communicate with an ATM.

21 *Facts Related To The Level Of Skill In The Art*

22 08. Neither the Examiner nor the Appellants has addressed the level
23 of ordinary skill in the pertinent arts of systems analysis and
24 programming, on line banking systems, automated teller machine

1 design, or commercial financial transaction system design. We
2 will therefore consider the cited prior art as representative of the
3 level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261
4 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific
5 findings on the level of skill in the art does not give rise to
6 reversible error ‘where the prior art itself reflects an appropriate
7 level and a need for testimony is not shown’”) (quoting *Litton*
8 *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163
9 (Fed. Cir. 1985)).

10 *Facts Related To Secondary Considerations*

11 09. There is no evidence on record of secondary considerations of
12 non-obviousness for our consideration.

13 PRINCIPLES OF LAW

14 *Obviousness*

15 Section 103 forbids issuance of a patent when ‘the differences
16 between the subject matter sought to be patented and the prior art are
17 such that the subject matter as a whole would have been obvious at
18 the time the invention was made to a person having ordinary skill in
19 the art to which said subject matter pertains.’

20 *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

21
22 In *Graham*, the Court held that that the obviousness analysis is
23 bottomed on several basic factual inquiries: “[1] the scope and content of
24 the prior art are to be determined; [(2)] differences between the prior art and
25 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
26 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550

1 U.S. at 406. “The combination of familiar elements according to known
2 methods is likely to be obvious when it does no more than yield predictable
3 results.” *Id.* at 416.

4 ANALYSIS

5 As discussed *supra*, the claims are drawn to modifying ATM’s so cash
6 can be withdrawn from commands from a cellular telephone. *See* claim 1
7 limitation (b), and claim 8, limitation (6). The Appellants present numerous
8 arguments, but the dispositive argument is that none of the references
9 suggest using a cellular telephone to operate an ATM. *See* App. Br. 7 and 8;
10 *see also* Reply Br. 1-2.

11 The Examiner did not find that any of the references describe using a
12 cellular telephone to operate an ATM. Instead, the Examiner found that
13 Suer described using a wireless device to operate an ATM and that a cellular
14 telephone is a species of the wireless device genus. Ans. 4. We agree with
15 this finding as far as it goes. The issue is showing that the species of cellular
16 telephone was a predictable alternative to the species of wireless devices
17 described by Suer (Suer was the only reference describing such a use for
18 wireless devices). The Examiner concluded it was obvious to use the
19 cellular telephone to attract customers having different devices.

20 This is not enough to present a *prima facie* case. As the Appellants
21 argued, if a reference shows a species, that does not block a patent to another
22 species. App. Br. 15. The fact that a claimed species or subgenus is
23 encompassed by a prior art genus is not sufficient by itself to establish a

1 *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382 (Fed. Cir.
2 1994).

3 The Examiner then went on to find that using a cellular telephone would
4 not affect Suer's system because Suer's system is merely used for the
5 purpose of facilitating wireless communication with another terminal. *Id.*

6 This is not accurate. In *Graham v. John Deere Co.*, 383 U.S. 1, 13-14
7 (1966), differences between the prior art and the claims at issue are to be
8 ascertained. The differences between Suer and the claimed cellular
9 telephone per se are in the capacity for use of Suer's device that a cellular
10 phone would not necessarily have, as follows. (1) Suer is directed to a hand-
11 held device that has the capacity to record financial transactions information
12 and make an electronic record of the transaction, so that the user can
13 electronically store information about a check transaction while writing the
14 check. FF 02. (2) Suer's device provides a check writing surface that
15 supports a check as it is being filled out by the user, that captures the
16 handwritten payee information as it is being written, and that stores the
17 payee information in a bit-map format in the device's memory. FF 03. (3)
18 Suer's portable hand-held device may automatically grant an accounting
19 software program, such as Quicken, access to the financial transaction
20 information. FF 04. (4) Suer's device may use a transceiver, such as an
21 infrared (IR) transceiver, for wireless communication between the device
22 and a terminal unit, such as a personal computer, an ATM, or a terminal at a
23 merchant's site to transfer information about a financial transaction to
24 accounting programs running on the PC. This allows the user to more
25 quickly and easily communicate between the accounting data and the
26 terminal unit. FF 05.

1 The Examiner has provided no evidence that the cellular telephone
2 species of wireless devices would perform as the species described by Suer.
3 The Examiner did not even produce evidence or make a finding that it was
4 predictable to incorporate a cellular telephone in Suer's PDA, or to
5 incorporate Suer's PDA in a cellular telephone.

6 Thus, we find the Appellants' arguments persuasive as to both
7 independent claims 1 and 8 and claims 2-7, 22, and 27-29 depending from
8 them.

9 As to claims, 23, 25, and 26, these claims depend from cancelled claims
10 20 and 15, and so purport to incorporate non-existent claim limitations. As a
11 procedural matter, we reverse the rejection of these claims under § 103. A
12 rejection of a claim, which is so indefinite that "considerable speculation as
13 to meaning of the terms employed and assumptions as to the scope of such
14 claims" is needed, is likely imprudent. *See In re Steele*, 305 F.2d 859, 862
15 (CCPA 1962) (holding that the examiner and the board were wrong in
16 relying on what at best were speculative assumptions as to the meaning of
17 the claims and basing a rejection under 35 U.S.C. § 103 thereon.) We find it
18 imprudent to speculate as to the scope of claims 23, 25, and 26 in order to
19 reach a decision on the obviousness of the claimed subject matter under §
20 103. It should be understood, however, that our reversal is based on the
21 indefiniteness of the claimed subject matter and does not reflect on the
22 merits of the underlying rejection.

NEW GROUND OF REJECTION

2 The following new ground of rejection is entered pursuant to 37 C.F.R. §
3 41.50(b). Claims 23, 25, and 26 are rejected under 35 U.S.C. § 112, second
4 paragraph, as failing to particularly point out and distinctly claim the
5 invention.

6 The test for definiteness under 35 U.S.C. § 112, second paragraph, is
7 whether “those skilled in the art would understand what is claimed when the
8 claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety*
9 *Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations
10 omitted).

11 Each of these claims is written in dependent form incorporating the
12 subject matter of a cancelled parent claim. Claim 23 claims dependence
13 from cancelled claim 20, and claim 25 claims dependence from that claim
14 23. Claim 26 claims dependence from cancelled claim 15. Thus, each of
15 these claims purports to incorporate non-existent subject matter, and so we
16 enter a new ground of rejection of claims 23, 25, and 26 under 35 U.S.C. §
17 112, second paragraph, as being indefinite for failing to particularly point
18 out and distinctly claim what Appellants' intend as their invention.

CONCLUSIONS OF LAW

20 The Appellants have sustained their burden of showing that the
21 Examiner erred in rejecting claims 1-8, 22, and 27-29 under 35 U.S.C. §
22 103(a) as unpatentable over Suer, Norris, and Gustin.

As a procedural matter, we reverse the rejection of claims 23, 25, and 26 under § 103(a) because we find it imprudent to speculate as to the scope of

1 claims 23, 25, and 26 in order to reach a decision on the obviousness of the
2 claimed subject matter.

3 A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).
4 Claims 23, 25, and 26 are rejected under 35 U.S.C. § 112, second paragraph,
5 as failing to particularly point out and distinctly claim the invention.

6 DECISION

7 To summarize, our decision is as follows.

- 8 • The rejection of claims 1-8, 22, 23, and 25-29 under 35 U.S.C. §
9 103(a) as unpatentable over Suer, Norris, and Gustin is not sustained.
10 • A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).
11 ○ Claims 23, 25, and 26 are rejected under 35 U.S.C. § 112,
12 second paragraph, as failing to particularly point out and
13 distinctly claim the invention.

14 This Decision contains a new rejection within the meaning of 37 C.F.R.
15 § 41.50(b) (2007).

16 Our decision is not a final agency action.

17 37 C.F.R. § 41.50(b) provides that Appellants, WITHIN TWO
18 MONTHS FROM THE DATE OF THE DECISION, must exercise one of
19 the following two options with respect to the new rejection:

- 20 (1) Reopen prosecution. Submit an appropriate amendment of
21 the claims so rejected or new evidence relating to the claims
22 so rejected, or both, and have the matter reconsidered by the
23 Examiner, in which event the proceeding will be remanded
24 to the Examiner. . . .
- 25 (2) Request rehearing. Request that the proceeding be reheard
26 under § 41.52 by the Board upon the same record. . . .

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1 No time period for taking any subsequent action in connection with this
2 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. §
3 1.136(a)(1)(iv) (2007).

4

REVERSED

41.50(b)

7

8

9

10 mev

11

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